

THIS DISPOSITION IS NOT
CITABLE PRECEDENT OF
THE TTAB

Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Sunrider Corporation dba Sunrider International

v.

Mineral Works

Opposition No. 117,420
against Application No. 75/380,221,
filed October 27, 1997

Richard M. Johnson of Ladas & Parry for The Sunrider
Corporation dba Sunrider International.

David J. Haenel, P.C. for Mineral Works.

Before Simms, Hairston and Bottorff, Administrative
Trademark Judges:

Opinion by Simms:

The Sunrider Corporation dba Sunrider International
(opposer), a Utah corporation, has opposed the application
of Mineral Works (applicant), an Idaho limited liability
company, to register the mark VITALIZE for mineral-vitamin

health supplements.¹ Both parties have taken testimony and submitted other evidence. The parties have filed briefs and an oral argument was held.²

We sustain the opposition.

As grounds for opposition, opposer asserts that it has sold nutritional products under the mark VITALITE since 1985; that it owns Registration No. 1,884,547, for this mark for nutritional supplements in all forms, including tablets, capsules, liquids and powders, food supplements, dietary food supplements, herbs, herbal juices, teas, protein used as a food additive, vegetable extracts and dried and processed fruits and vegetables; that its mark has achieved substantial and valuable goodwill and recognition; that opposer has priority of use; and that applicant's mark VITALIZE so resembles opposer's mark VITALITE as to be likely to cause confusion, to cause mistake or to deceive. In its answer applicant has denied these allegations. Pursuant to stipulation approved by the

¹Application Serial No. 75/380,221, filed October 27, 1997, based upon allegations of use since August 13, 1997.

²Opposer submitted various exhibits including applicant's discovery responses with its trial brief. It appears that this material was submitted in support of opposer's evidentiary objections to applicant's record and not as a part of its trial record. We have considered this material in this light--that is, only to show that applicant has allegedly not fully answered opposer's discovery requests.

Opposer has moved to strike applicant's brief because, although it was due March 14, 2002, it was not filed until March 15. Because applicant's brief was just one day late, we exercise our discretion and accept applicant's brief. Accordingly, opposer's motion to strike is denied.

Board on August 3, 2001, the Board struck various affirmative defenses set forth in applicant's answer.

Evidentiary Objections

We deal first with opposer's evidentiary objections raised in its brief. On the basis of the following facts, opposer asks us to exclude evidence of any facts withheld by applicant during discovery, and to exclude any opinion testimony of applicant's witness because he was not identified as an expert witness during discovery, as required by Fed.R.Civ.P. 26(a)(2). Opposer's interrogatories Nos. 20-22 asked applicant to describe "fully the factual basis on which Applicant relied in asserting the affirmative defense" that there is no likelihood of confusion.³ Applicant responded that it had not determined the complete factual basis for this "affirmative defense" and that, as additional facts become available, applicant would supplement its response. A supplemental response was provided, which merely referred to other discovery responses. No third-party registrations were identified by applicant as a reason or reasons for applicant's belief that there was no likelihood of confusion.

³While in its answer applicant has labeled its denial of likelihood of confusion as an "affirmative defense," strictly speaking we do not view such a denial as an affirmative defense. Affirmative defenses include such matters as estoppel, laches and acquiescence.

It is applicant's position that all evidence was disclosed during discovery. In any event, applicant maintains that a party need not, in advance of trial, specify in detail all the evidence it intends to present or to identify its witnesses (except expert witnesses).

One of the factors used in determining likelihood of confusion is the number and nature of similar marks in use on similar goods. See *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Opposer has not cited any authority for the proposition that a defendant must specifically plead that there is no likelihood of confusion because of the issuance of third-party registrations. Moreover, applicant is correct that, under established Board precedent, a party is not obligated to specify in advance of trial all of the evidence it intends to present. See *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989) and TBMP §419(7). Finally, opposer's president was not called as an "expert witness" but only to testify concerning applicant's use of its mark. Any opinions expressed during his testimony were not those of a trademark expert but only those of the president of a manufacturer of nutritional supplements. Accordingly, we overrule opposer's objections and have considered the third-party registrations which

applicant submitted by notice of reliance, as well as the testimony submitted by applicant.

Opposer's Record

Opposer took the testimony of Dr. Oi-Lin Chen, opposer's president. She testified that opposer has been using the mark VITALITE for weight management nutritional supplements since 1985. Chen dep., 14. Opposer now sells a variety of products including nutritional supplements, vitamin supplements with minerals, herbal supplements, herbal drinks and meal replacement products. For many of these products, opposer uses the mark VITALITE as a house mark with different product marks (for example, Fortune Delight, Action Caps, Sunbars, etc.). Dr. Chen testified that opposer owns pleaded Registration No. 1,884,547 (issued March 21, 1995, Sections 8 and 15 affidavit or declaration accepted and acknowledged) for the mark VITALITE.

Opposer sells its nutritional products to distributors and directly to consumers. Dr. Chen testified that some of opposer's distributors are also herbal shop owners. Chen dep., 50. Opposer currently has over 100,000 distributors in this country.

Opposer promotes its goods by a variety of means including distributor kits, catalogs for distributors as

well as ultimate customers, brochures, monthly newsletters and magazines to distributors and customers (about 10,000 per month), its Web site, and at periodic conventions of distributors. Opposer's sales in the year 2000 exceeded \$11 million, with total sales of over \$60 million over the last seven years. Chen dep., 72. (Opposer submitted no evidence with respect to its advertising expenditures.) Dr. Chen testified that opposer's products are widely distributed and that opposer's mark is recognized throughout the United States. Chen dep., 59.

Dr. Chen further stated that applicant's nutritional product is similar to some of opposer's products, and that applicant's trade dress is also similar to opposer's, both depicting active and energetic people.

Applicant's Record

Applicant's president and director of marketing, Mr. T. Darwin Porter, testified concerning applicant's VITALIZE liquid nutritional supplement. Sold in 32-ounce bottles, this is a full-spectrum liquid nutritional product containing 93 nutrients--15 vitamins, major minerals, 11 antioxidants and 70 trace minerals. Applicant also sells a VITALIZE product in one-ounce packets, to be mixed with water. Since 1999, applicant has sold VITALIZE G3

nutritional supplements, similar to the original product but with three additional herbal extracts.

While opposer's products are sold through multi-level or network marketing, applicant's president testified that applicant sells its products in health food stores in 13 states, by direct mail throughout the United States and over the Internet.

Mr. Porter, while indicating that applicant's trade dress depicts adults who look young, vibrant and energetic, stated that the size, weight and use or purpose of the respective products are different, and expressed the opinion that the trade dress of the respective products are different.

Applicant has also relied upon various third-party registrations of marks beginning with the prefix "VITA-", the most pertinent of which is Registration No. 1,214,642, issued November 2, 1982 (renewed), for the mark VITALINE for dietary supplements, and Registration No. 1,817,037, issued January 18, 1994 (Sections 8 and 15 accepted and acknowledged), for the mark VITALITE for frozen yogurt and ice milk. Finally, Mr. Porter testified, at 88, that there have been no instances of actual confusion.

Arguments of the Parties

Opposer argues that it has proved priority (by testimony and its registration). With respect to the issue of likelihood of confusion, opposer argues that the respective marks are similar in sound, appearance and meaning, and that the goods in its registration and in applicant's application are identically described. In this regard, we note that opposer relies exclusively on its Class 5 goods (nutritional supplements, food supplements, herbs, herbal juices and teas), and not its Class 29 goods. Appeal brief, 5, 12, 13 and 14. Further, opposer notes that there are no restrictions on channels of trade in its registration or applicant's application. Any registration which applicant may obtain will not be limited, opposer contends, with respect to channels of trade, and applicant will be entitled to offer its goods bearing its mark in any channel of trade, not just the one presently being used by applicant (retail health food stores). Moreover, opposer argues that its own goods have been sold in some "herbal shops" as well.

Opposer also argues that the mark VITALITE has achieved fame. Finally, opposer contends that the absence of bad faith on the part of applicant does not diminish the likelihood of confusion.

While acknowledging that there is no issue with respect to priority in this case (appeal brief, 1 and 14), applicant maintains that the marks are different and that the parties' goods are different and travel in different channels of trade. In particular, applicant argues that the shared prefix "VITA-", meaning "life," is a weak element and not sufficient to support a finding of likelihood of confusion. Applicant notes the third-party registrations of record, including that for the mark VITALINE for dietary supplements and for VITALITE for frozen yogurt and ice milk. Not surprisingly, applicant focuses on the suffixes of the parties' marks, arguing that they look and sound differently. Applicant argues that opposer's mark VITALITE connotes lightness and possible weight loss while its mark VITALIZE connotes action and energy. Applicant also notes that opposer's mark is usually used as a house mark with other product marks.

Concerning the goods, applicant maintains that they are specifically different food supplements with different compositions, opposer's product being an herb-based dietary food supplement focused on weight management while applicant's goods are a liquid nutritional vitamin and energy supplement. Further, applicant points to opposer's multi-level marketing while applicant sells its goods in

retail stores in 13 states and otherwise through direct retail mail companies and the Internet.

While applicant concedes (brief, 14) that opposer's mark may be famous "within the societal subculture of network marketing," applicant insists that the record does not establish fame beyond that specific marketing channel. Finally, applicant notes the evidence with respect to the lack of actual confusion as well as the fact that there is no evidence of any bad faith on applicant's part.

Opinion and Decision

First, opposer's testimony and evidence clearly establish its prior use. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, applicant has admitted opposer's priority.

Turning to the issue of likelihood of confusion, the determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood-of-confusion factors set forth in *duPont*, *supra*. In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v.*

Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and cases cited therein.

Considering first the marks, the test is not whether they can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We consider the marks' sound, appearance and meaning. Both marks, while not identical in sound, are pronounced in a similar manner, with the same prefix and a long "i" sound in last syllable. Except for the next to last letter in both marks, they are identical in appearance. In connotation or meaning, the marks do have differences in meaning, opposer's mark ending in a suffix suggesting lightness or possibly fewer calories, while applicant's mark is a word suggesting vitality or vigor.

Furthermore, while opposer often uses the mark VITALITE with other product marks, opposer nevertheless

owns a registration of the mark VITALITE *per se*, and this is the mark which we must compare to the mark applicant seeks to register. On balance, therefore, the similarities of the marks place this factor on the side of opposer.

See, for example, *Floralife, Inc. v. Floraline International, Inc.*, 225 USPQ 683 (TTAB 1984)(likelihood of confusion found between FLORALIFE and FLORALINE).

Although we cannot agree with opposer that its mark has achieved the status of a famous mark in the field of nutritional supplements, we believe that the long use (nearly 17 years) and substantial sales of its products (over \$60 million) has resulted in substantial recognition by at least some of the relevant consuming public.

Turning to the goods of the parties, it has been repeatedly held that, in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this regard, we note that

opposer's nutritional and dietary food supplements are, in essence, identical to applicant's mineral-vitamin health supplements. Also, there is no restriction in the channels of trade or classes of purchasers of the parties' Class 5 nutritional supplements.⁴ We must assume, therefore, that those goods can and do travel in the same channels of trade to the same classes of purchasers. We conclude that opposer's nutritional supplements in all forms are substantially identical to applicant's vitamin and mineral health supplements. This factor, too, is in opposer's favor.

A further factor in opposer's favor is the fact that these nutritional supplements are relatively inexpensive. These goods may be purchased without a great deal of care in the purchasing decision.

While we have considered the third-party registrations made of record by applicant, there is only one which is similar to that of the parties (VITALINE for dietary supplements), but there is no evidence of record concerning the use of that mark or any recognition by the relevant class of purchasers. Third-party registrations are not evidence that the marks therein are in use in commerce or

⁴We do note that, with respect to opposer's Class 29 products (protein used as a food additive, vegetable extracts, dried and processed fruits and vegetables), the registration indicates that these goods are sold directly to consumers and not through retail outlets.

that the public is familiar with them. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The fact that there have been no instances of actual confusion may be explained by the fact that the current channels of trade are largely different (multi-level marketing through distributors vs. retail health food stores). This factor is of little weight in view of the manner in which we must analyze the issue of likelihood of confusion (the descriptions of goods in the registration and application, which lack any restriction as to channels of trade of the relevant goods).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997).

Decision: The opposition is sustained and registration to applicant is refused.